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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,684	07/28/2000	Jaakko Rajaniemi	975.311USW1	3794

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EXAMINER

SMITH, SHEILA B

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 04/08/2004

26

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**Application No. **PR4**

09/627,684

Applicant(s)

RAJANIEMI, JAAKKO

Examiner

Sheila B. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-21 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 25.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 6, 9, 15, 19, 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Dean et al. (U. S. Patent Number 6,173,173)

***Regarding claims 1, 19, and 20,*** Dean et al. discloses all the claimed invention as set forth in the instant application, in addition Dean et al. discloses a invalid mobile telephone call terminating system and method further Dean et al. discloses a method for performing a detach of a terminal registered to a network by associating an identification for terminal deriving a signature for identification, and allocation a pair consisting of (which reads on client's request number) and "identification signature" (which reads on signature dn,) terminal, method comprising the steps of comprising "sending a detach request" (which reads on kill call request message) detach request including identification and identification signature from registered terminal to network as disclosed (column 7 lines 62-67), receiving detach request at the network

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side as disclosed (column 4 lines 1-5), comparing received detach request with a record of registration date of terminal kept at the network side request as disclosed (column 8 lines 1-7), detaching terminal from network (which reads on tearing down from the network a call or kill call from the network as disclosed in column 1 lines 57-67), if received detach request coincides with said record of registration data as disclosed (column 8 lines 1-7) .

***Regarding claim 2***, Dean et al. discloses everything claimed, as applied above (see claims 1 ) additionally, Dean et al. specifically discloses sending of said detach request message is initiated upon detection of a predetermined state of said terminal (which reads on column 2 lines 16-20).

***Regarding claim 6***, Dean et al. discloses everything claimed, as applied above (see claims 1 ) additionally, Dean et al. specifically discloses wherein said record of registration data contains said pair consisting of said identification and said identification signature (which reads on client's request number) and "identification signature" (which reads on signature dn), and said comparison is effected for each of said data items forming said pair (which reads on column 7 lines 62-67).

***Regarding claims 9, 15***, Dean et al. discloses everything claimed, as applied above (see claims 1 ) additionally, Dean et al. specifically discloses wherein registration of a terminal to a telecommunication network, comprising the steps of associating an identification for said terminal (which reads on client's request number); deriving a signature for said identification (which reads on signature dn); and allocating a pair consisting of said identification and said signature to said terminal (which reads on column 7 lines 62-67).

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**Regarding claim 21**, Dean et al. discloses everything claimed, as applied above (see claims 1 ) additionally, Dean et al. specifically a telecommunication system consisting of at least one terminal and at least one network controlling device controlling at least one radio transceiver device, adapted to carry out the method (which reads on column 3 lines 20-27).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dean et al. in view of well known prior art.

**Regarding claim 3**, Dean et al. discloses everything claimed, as applied above (see claims 2) however, Dean et al. fails to specifically disclose said predetermined state is a power off state.

The examiner contends, however, that the predetermined state is a power off state is well known in the art and at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Dean with the teachings of well known prior art since it is known in the art to power the phone off if not in use or if there is no charge on the battery.

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**Regarding claim 4**, Dean et al. discloses everything claimed, as applied above (see claims 2) however, Dean et al. fails to specifically disclose predetermined state is a low battery state.

The examiner contends, however, that the predetermined state is a low battery state is well known in the art and at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Dean with the teachings of well known prior art since it is known in the art to power the phone off if not in use or if there is no charge on the battery.

**Regarding claim 5**, Dean et al. discloses everything claimed, as applied above (see claims 2) however, Dean et al. fails to specifically disclose said predetermined state resides in a removal of a SIM module from said terminal.

The examiner contends, however, that the predetermined state resides in a removal of a SIM module from said terminal is well known in the art and at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Dean with the teachings of well known prior art since it is known in the art to use a SIM module for storing information.

4. Claims 7, 8, 10-14,17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dean et al. in view of Kuriki (U. S. Patent Number 5,765,105).

**Regarding claims 7,8 ,17,18**, Dean et al. discloses everything claimed, as applied above (see claims 1) however, Dean et al. fails to specifically disclose temporary subscriber and international subscriber identity.

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In the same field of endeavor, Kuriki further discloses a communication system capable of using a plurality of subscriber identity media sharing a single subscriber identity information. In addition Kuriki discloses a international subscriber identity in column 1 lines 25-30.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to improve Dean et al. by modifying a invalid mobile telephone call terminating system and method with the use of a temporary subscriber and international subscriber identity as taught by Kuriki for the purpose of authenticating the number.

***Regarding claim 10***, Dean et al. discloses everything claimed, as applied above (see claims 1 ) however, Dean et al. fails to specifically discloses sending a registration request from terminal to network.

In the same field of endeavor, Kuriki further discloses a communication system capable of using a plurality of subscriber identity media sharing a single subscriber identity information. In addition Kuriki discloses a registration request from a terminal to network as disclosed in column 4 lines 25-34.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to improve Dean et al. by modifying a invalid mobile telephone call terminating system and method with the use of a registration request from a terminal to network as taught by Kuriki for the purpose of authenticating the number.

***Regarding claim 11***, Dean et al. discloses everything claimed, as applied above (see claims 1 ) however, Dean et al. fails to specifically discloses a registration request from terminal to network.

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In the same field of endeavor, Kuriki further discloses a communication system capable of using a plurality of subscriber identity media sharing a single subscriber identity information. In addition Kuriki. discloses a registration request from a terminal to network as disclosed in column 11 lines 48-64.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to improve Dean et al. by modifying a invalid mobile telephone call terminating system and method with the use of a registration request from a terminal to network as taught by Kuriki for the purpose of authenticating the number.

***Regarding claim 12***, Dean et al. discloses everything claimed, as applied above (see claims 1 ) however, Dean et al. fails to specifically discloses a registration request is a location update request for updating a previous registration of said terminal in said network.

In the same field of endeavor, Kuriki further discloses a communication system capable of using a plurality of subscriber identity media sharing a single subscriber identity information. In addition Kuriki. discloses a registration request is a location update request for updating a previous registration of said terminal in said network as disclosed in column 11 lines 48-64.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to improve Dean et al. by modifying a invalid mobile telephone call terminating system and method with the use of a registration request from a terminal to network as taught by Kuriki for the purpose of authenticating the number.



***Regarding claim 13***, Dean et al. discloses everything claimed, as applied above (see claims 1 ) however, Dean et al. fails to specifically disclose a registration request is a cell update request for updating a previous registration of said terminal in said network

In the same field of endeavor, Kuriki further discloses a communication system capable of using a plurality of subscriber identity media sharing a single subscriber identity information. In addition Kuriki discloses a registration request is a cell update request for updating a previous registration of said terminal in said network as disclosed in column 11 lines 48-64.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to improve Dean et al. by modifying a invalid mobile telephone call terminating system and method with the use of a registration request from a terminal to network as taught by Kuriki for the purpose of authenticating the number.

***Regarding claim 14***, Dean et al. discloses everything claimed, as applied above (see claims 1 ) however, Dean et al. fails to specifically disclose a registration request is a URA update request for updating a previous registration of said in said network.

In the same field of endeavor, Kuriki further discloses a communication system capable of using a plurality of subscriber identity media sharing a single subscriber identity information. In addition Kuriki discloses a registration request is a URA update request for updating a previous registration of said in said network as disclosed in column 11 lines 48-64.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to improve Dean et al. by modifying a invalid mobile telephone call terminating system and method with the use of a registration request is a URA update request for

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updating a previous registration of said in said network as taught by Kuriki for the purpose of authenticating the number.

***Regarding claim 16***, Dean et al. in view of Kuriki discloses everything claimed, as applied above (see claims 9) however, the combination of Dean et al. in view of Kuriki fails to specifically disclose allocating is effected in a secure mode.

The examiner contends, however, that the allocating is effected in a secure mode is well known in the art and at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Dean et al. in view of Kuriki with the teachings of well known prior art since it is known in the art allocating is effected in a secure mode to protect against fraud.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheila B. Smith whose telephone number is (703)305-0104. The examiner can normally be reached on Monday-Thursday 6:00 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika Gary can be reached on 703-308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Smith 

April 2, 2004

  
ERIKA GARY  
PATENT EXAMINER